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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,416	01/26/2001	Daniel Pellerin	13493	6341

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EXAMINER

MOHANDESI, JILA M

ART UNIT PAPER NUMBER

3728

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/771,416	Applicant(s) PELLERIN, DANIEL	
	Examiner Jila M Mohandesi	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Upon further review and consideration of the claims, the finality of the rejection of the last Office action mailed July 13, 2004 is withdrawn. The after final amendment filed November 17, 2004 has not been entered.
2. The indicated allowability of claims 4-7 and 9 is withdrawn in view of the newly discovered reference(s) to Ueda et al. (5,943,795) and Dassler (4,523,396). Rejections based on the newly cited reference(s) follow.

Request for Continued Examination

3. The request filed on 19 May 2003 for a request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/771,416 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 10-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 10, lines 12-13 and claim 11, lines 40-41, the limitation "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" and claim 15, lines 6-7, the

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limitation "with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses" , and claim 18, lines 6-7, the limitation "with a longest side being shorter than the longest of any of said straight line sides of the recesses, claim 19, lines 13-14, the limitations "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" and claim 23, lines 8-9, the limitation "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" are new matter. These limitations are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-3, 8 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether the applicant intends to claim the combination of a cleat and a baseball shoe or is claiming the subcombination of a cleat for use with the baseball shoe. This is because in many instances claims which appear to be drawn only to the subcombination of the cleat (no baseball shoe has been claimed), are further structurally limited with reference to the baseball shoe. For example only, claim 1, line 1 appears to clearly indicate that no baseball shoe is claimed (the claim is drawn to a cleat for use with a baseball shoe). On the other hand line 2 recites limitation which are

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dependent on the size of the recess in the baseball shoe. All of the claims should be reviewed for this type of error. With respect to claims such as claims 2, and 16 the claims actually appear to recite that there is a baseball shoe while also appearing (at least from the preamble thereof) to be drawn only to the subcombination of a cleat for use with a baseball shoe. In this office action all references in the claims to the baseball shoe where they are not expressly recited in combination with the claimed cleat is not considered to be further structurally limiting with respect to the cleat. The examiner will treat such references to the baseball shoe as merely the applicant's statement of intended use of the cleat in order to give the claims their broadest reasonable interpretation pursuant to PTO practice. On the other hand clarification of the scope of the above noted claims is required in response to this office action.

Specification

8. The amendment filed May 20, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The phrase "has a generally isosceles and /or equilaterally triangular shape recess formed about the receptacle" is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. It is noted that the term “universal cleat” in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipate by Rogers (1,055,229). Rogers `229 discloses a cleat for a baseball shoe comprising:

- a) a generally triangular base (baseball spike plate 1) with substantially flat bottom;
- b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base (See Figure 1 embodiment);
- c) an oblong shaped mounting hole in the base.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that “recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed, “*Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983).

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Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

The oblong shape mounting hole of Rogers `229 is inherently capable of receiving a retaining screw.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-3 and 8 are rejected under 35 U.S.C. 103(a) as being obvious over Rogers `229.

With respect to claims 2 and 8, it would have been an obvious matter of design choice to modify the size of the base of the cleat since such a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With regard to claim 3, the ratio of the length of the mounting hole to the width of the mounting hole would be a design choice depending on the shape and size of the mounting hole.

14. Claims 1, 3-4, 6-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) and Ueda et al. (5,943,795). Tanel '292 discloses an universal cleat suitable for use for multiple different baseball shoes, the shoes having a recess in the sole (column 8, lines 63-66) for receiving a cleat, the cleat comprising a generally triangular base (11) with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes (column 9, lines 1-3); a grip (13) projecting from the base in a plane substantially perpendicular to the plane of the base; and a mounting hole (29) in the base, the mounting hole can have any convenient shape (column 7, line 6-8). Tanel '292 does not appear to have a threaded opening in the recess for receiving a retaining screw to hold the cleat in place and for the mounting hole to be oblong shaped. Kawashima '693 discloses a baseball shoe having a recess (5) with threaded opening (4) therein for receiving a retaining screw (9) to hold a cleat (8) in place and allow for easier replacement of the cleat. Ueda '795 discloses that it is desirable to have the mounting hole oblong shape for connecting the cleat to the sole to allow more adjustability. See Figure 7 embodiment. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a threaded opening in the recess of Tanel '292 for receiving a retaining screw as taught by Kawashima '693 to better secure the cleat to the sole. Also, it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to make the mounting hole of Tanel '292 oblong shaped as taught by Ueda '795 to allow more adjustability.

With regard to claims 3 and 6, the ratio of the length of the mounting hole to the width of the mounting hole as modified appears to be 8:7 to about 10:7.

15. Claims 2, 5 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claims 1 and 4 above, and further in view of Dassler (4,523,396). Tanel '292 as modified above discloses all the limitations of the claims except for the specific area of the base with respect to the area of the recess. Dassler '396 discloses a shoe with a sole having a plurality of recesses for receiving a cleat. Dassler '396 discloses that depending on the shape of the base of the cleat there is no need for the fit between the inside wall of the openings/recesses (4) and the circumference of the base parts (5) to be too close therefore allowing the cleat to wiggle in the recess in the absence of the retaining fastener. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to Make the area of the base of the cleat smaller than the area of the recess as taught by Dassler 396 for easier interchangeability of the cleats.

With regard to claims 8 and 9, it appears that the area of the base is from 85 to 95% of the area of the recess, furthermore, the relationship between the area of the base and the area of the recess will depend on the type and shape of cleat being used.

Response to Arguments

16. The declaration under 37 CFR 1.132 filed 14 March 2003 is insufficient to overcome the rejection of claims 1-9 based upon the rejection of claims 1-9 under 35

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U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) as set forth in the last Office action because: The declaration does not set forth facts and does not demonstrate that the commercial success is due to the invention alone.

Conclusion

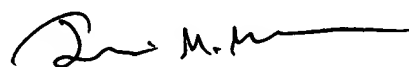
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are cleats analogous to applicant's inventions.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI
PRIMARY EXAMINER**



Jila M Mohandesi
Primary Examiner
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